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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/735,148	12/12/2003	Choong Paul Kim	51667/RDS/C543	1555	
23363 7590 05/19/2006 CHRISTIE, PARKER & HALE, LLP			EXAMINER		
			WYSZOMIERSKI, GEORGE P		
PO BOX 7068 PASADENA, CA 91109-7068			ART UNIT	PAPER NUMBER	
			1742		
			DATE MAILED: 05/19/2006		

Please find below and/or attached an Office communication concerning this application or proceeding.

		<i>▶</i>	_
	Application No.	Applicant(s)	_
	10/735,148	KIM ET AL.	
Office Action Summary	Examiner	Art Unit	_
	George P. Wyszomierski	1742	
The MAILING DATE of this communication ap Period for Reply	ppears on the cover sheet with t	he correspondence address	
A SHORTENED STATUTORY PERIOD FOR REPI WHICHEVER IS LONGER, FROM THE MAILING [- Extensions of time may be available under the provisions of 37 CFR 1 after SIX (6) MONTHS from the mailing date of this communication If NO period for reply is specified above, the maximum statutory period - Failure to reply within the set or extended period for reply will, by statu Any reply received by the Office later than three months after the maili earned patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNICAT .136(a). In no event, however, may a reply d will apply and will expire SIX (6) MONTHS te, cause the application to become ABAND	TION. be timely filed from the mailing date of this communication. ONED (35 U.S.C. § 133).	
Status			
1) Responsive to communication(s) filed on 06.	April 20 <u>06</u> .		
2a) ☐ This action is FINAL . 2b) ☑ Th	is action is non-final.		
3) Since this application is in condition for allow	·		
closed in accordance with the practice under	Ex parte Quayle, 1935 C.D. 11	, 453 O.G. 213.	
Disposition of Claims			
4) Claim(s) 1-13 is/are pending in the application 4a) Of the above claim(s) is/are withdrates 5) Claim(s) is/are allowed. 6) Claim(s) 1-13 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/	awn from consideration.		
Application Papers			
9) The specification is objected to by the Examination The drawing(s) filed on is/are: a) ac Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Examination is objected.	cepted or b) objected to by t e drawing(s) be held in abeyance. ction is required if the drawing(s) is	See 37 CFR 1.85(a). s objected to. See 37 CFR 1.121(d).	
Priority under 35 U.S.C. § 119			
12) Acknowledgment is made of a claim for foreig a) All b) Some * c) None of: 1. Certified copies of the priority documer 2. Certified copies of the priority documer 3. Copies of the certified copies of the pri application from the International Burea * See the attached detailed Office action for a list	nts have been received. nts have been received in Appli ority documents have been rec au (PCT Rule 17.2(a)).	cation No eived in this National Stage	
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date		nary (PTO-413) nil Date nal Patent Application (PTO-152)	

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United

States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by the

Liu et al. J. Mater. Res. article.

Liu et al. discloses an amorphous magnesium-base alloy containing a bcc metal phase

distributed throughout. The bcc phase is in the general form of particles that precipitate in situ

as a molten composition is cooled and solidified. The examiner's position is that the prior art

materials are sufficiently "ductile" to meet the generic recitation of this term in the claim, in the

absence of any numerical meaning of the term "ductile". Thus, all aspects of the claimed

invention are held to be fully met by Liu et al.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

the Liu et al. article.

The Liu reference, discussed supra, does not specify the volume percentage of second

phase as set forth in the instant claims. However, Liu indicates that the amount of the bcc

phase in the prior art increases with increasing Li content; see the left hand column of page

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2389 of Liu and also the left hand column of page 2392 of Liu. It is thus a reasonable assumption that one skilled in the art would have easily been able to arrive at a composition having the presently claimed volume percentage of second phase by increasing the Li content to an appropriate level. Thus, a prima facie case of obviousness is established between the disclosure of Liu et al. and the presently claimed invention.

5. Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/288492.

Although the conflicting claims are not identical, they are not patentably distinct from each other because while the '492 claims contain limitations not specified in the instant claims, it would appear that practicing the invention as defined in, e.g. '492 claim 1 would inherently involve practicing an invention in accord with instant claim 1. The last three lines of '492 claim 1 are essentially the same as the invention recited in instant claim 1. Further, many of the preferred embodiments of the invention are recited in both the instant claims and the '492 claims; compare for instance instant claim 3 with '492 claim 6, instant claim 4 with '492 claim 15, or instant claims 5 and 7 with '492 claim 11. Thus, the claimed invention is not seen to define a material patentably distinct from what is recited in the claims of the '492 application.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. In a response filed April 20, 2006, Applicant alleges that the newly claimed term "ductile" distinguishes the claimed products from those of Liu et al. Applicant's arguments have been carefully considered, but are not persuasive of patentability because the word "ductile" is a relative term, and does not imply any specific level of ductility. While Applicant states that the present specification discloses the ductility of the presently claimed materials, none of this disclosure is recited or claimed in such a manner that the claimed products would be distinguishable from those of the prior art. The specification and claims do not indicate precisely how "ductile" an amorphous metal object have to be in order to fall within the metes and bounds of the claimed invention.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the <u>new central facsimile number</u>, (571)-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GEORGE WYSZOMIERSK PRIMARY EXAMINER GROUP 1700

GPW May 15, 2006